

Application number: 09/827788

Art Unit: 3625

Applicant: Khai Hee Kwan

Examiner: Robert Rhode.

Title: Computer Network Method for conducting payment over a network by debiting and crediting telecommunication accounts.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TO: Commissioner for Patents
Alexandria, VA 22313-1450

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FEB 1 - 2006

Sir:

RE: Supplementary response under 37 CFR 1.116(e) to introduce additional evidence after final rejection mailed Dec 2, 2005.

Restating the Issue.

In the final rejection, the examiner introduced Woodhill US Pat 6934858 (claiming earliest filing date Dec 15, 1999) to reject this application's main independent claim 1 which is the representative. In particular, Woodhill teaches using of TWO networks to authenticate users.

The Applicant's submission.

Generalizing, the applicant wish to submit that Woodhill may not be the first to invent this method of using TWO networks for authentication.

The applicant discover about 4 days ago that my own US application 09-395005 (US filing date Sept 13-1999) which is pending also provided such teaching.

The evidence.

For example in 09-395005 specification as originally filed; see page 7 line 13 to line 20.

One set of these codes is sent by the merchant system to the buyer in the form of an encrypted email and another to the host computer. For anonymous payment, on receiving this code, the buyer has to log onto the World-Wide-Web site of this Invention (the host computer) to input this code which usually has a timed life. This code will be analysed and matched to the merchant's code and the details of the purchase will be shown for verification. Alternative if he/she has an account or call a special number and follow the instructions to complete the purchase.

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ALSO See page 8 line 5 -10

Even the email is intercepted, the code is encrypted and of little use. Up to the point where the codes are physically inputted back using computer keyboard or telephone pad and transmitted to the host computer, it has no value at all. For account users, a safety feature here is that only buyers can logon to complete the transaction as the password, computer IP address and telephone number are recorded as well.

Discussion.

As explained above, a code is send via email (Internet) from Merchant server and this is re-entered via telephone pad by calling a special number PSTN), which is what Woodhill taught. It is also noted from the prosecution history that Claims 55 to 59 of Woodhill was added in reference to additional matter in the specification dated Oct 25, 2004. The applicant submits that our teaching above could read into these claims as they stand being the broadest.

Further Submission to the final rejection:

As argued in our earlier submission 14 Jan 2006, the pending claim 1 in application 09-827788 deals with using telecommunication accounts as the main feature for facilitating payment while employing two networks for security reasons so that the password will not be intercepted via first network. Therefore, one of the main element in Claim 1 is the fact that a password is send over a second network. Woodhill made no mention at all of using telecommunication accounts, no password via second network and only barely recognizing the use in combination with authorization to charge a financial account.

This is pertinent as Woodhill as explained wanted to use a device such as a telephone as something one have as opposed to something one knows as a way to authenticate the user. (See Woodhill provisional application 60/170808 at page 10 and we quote " The key insight is that a person's ability to answer a phone call at their own number behaves as "something you have" as opposed to "something you know". Also see that in the same provisional application at page 9, Woodhill actually discourage the use of password.

Secondly it is also pertinent the teaching of charging a financial account in Woodhill US Pat 6934858 at Col 21 line 63 and Col 22 line 38 to line 67 was ONLY ADDED through an amendment to the specification dated Oct 25, 2004 in response to a 35 USC 112 Para 1 rejection (See para 5 of Action Letter mailed July 22, 2004 rejecting Claims 52-54 and subsequent response by Woodhill at page 16 of said response mailed Oct 25, 2004). The current view in regards to original filed claims having their own descriptions satisfying

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35 USC 112 has been placed in doubt since the decision of the United States Court of Appeals for the Federal Circuit, the case of Lizardtech v Earth Resource Mapping Inc (case number 05-1062, decided Oct 4, 2005) and we quote "Finally, LizardTech argues that it is significant that claim 21 is part of the original disclosure and was not added at a later point. While it is true that an originally filed claim can provide the requisite written description to satisfy section 112, see Union Oil Co., 208 F.3d at 998 n.4, nothing in claim 21 or the specification constitutes an adequate and enabling description of all seamless DWTs." at page 20. Therefore, the applicant's question is whether the claims 52-54 and specification in Woodhill actually constitutes an adequate and enabling description at time of filing. Could it also be argued that Woodhill may have admitted that it was not adequate by including the additional amendment (specification) in order to advance his application? It must be noted that in Lizardtech case, there was no question of 35 USC 112 during prosecution and the claim 21 was allowed.

If this is accepted then this clearly shows Woodhill has not contemplated on using his invention as a payment processor, which is another main element found in our claim 1. In the final action, the examiner merely asserted that Woodhill has a payment processor but without any evidence (page 6 of action letter mailed 2 Dec 2005). Therefore, our submission is that Woodhill has failed to teach this payment processor element and therefore the examiner's rejection is unsustainable.

Explanation for lateness to submit this evidence under 37 CFR 1.116(e)

The applicant wish to submit that the lateness was due to the fact that the Applicant only came to know about this recently while doing some housekeeping for his other applications including 09-395005 which are currently pending. Given the Applicant has a number (almost 24 including provisional) of applications, it was not possible to remember all details or features peculiar in them. Furthermore, it has been a long time since the Applicant wrote 09-395005 and therefore had not revisited this feature in detail, until recently while checking on the status of the application.

As to the lateness of referring to the Lizardtech case, the applicant was also made aware of this in the last 2 days while reading a blog on the Internet. See <http://www.ip litigationblog.com/>

We respectfully ask the examiner to consider accepting our additional evidence.

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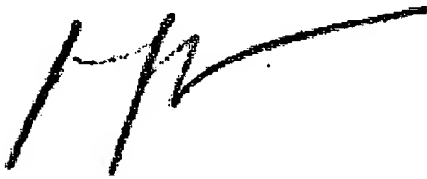
Applicant: Khai Hee Kwan

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Thanking you in advance.

Yours truly,

A handwritten signature in black ink, appearing to be 'KHAI KWAN', with a long horizontal stroke extending to the right.

Khai Kwan
Customer Number 023336

1 February, 2006

Included : Declaration

Total Pages faxed 5 including Declaration.

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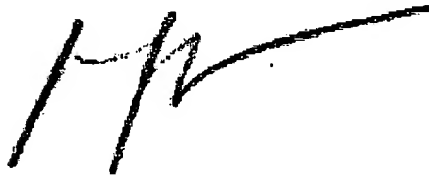
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Declaration 37 CFR 1.132

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any application, any patent issuing thereon, or any patent to which this verified statement is directed.



Khai Hee KWAN

315 Avoca St
Randwick NSW 2031
Australia

Date: 1 February, 2006

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